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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,441	08/23/2006	Hirokazu Inoue	41066	6096
116	7590	03/03/2009	EXAMINER	
PEARNE & GORDON LLP			VOGEL, NANCY TREPTOW	
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SUITE 1200			ART UNIT	PAPER NUMBER
CLEVELAND, OH 44114-3108			1636	
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			03/03/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/590,441	INOUE, HIROKAZU	
	<b>Examiner</b>	<b>Art Unit</b>	
	NANCY VOGEL	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,9,10 and 13-18 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,9,10 and 13-18 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>8/16/07, 9/25/06, 8/23/06</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: ____ .

## **DETAILED ACTION**

Claims 1-5, 9, 10, 13-15 are pending in the case.

Receipt of the Information Disclosure Statements on 8/16/07, 9/25/06, and 8/23/06 is acknowledged.

The information disclosure statement filed 8/23/06 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein which is crossed through has not been considered.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 3, 4, 5, 9, 10, 14, 15, 16, 17 are rejected under 35 U.S.C. 102(a) as being anticipated by Ninomiya et al. (PNAS, 101, 33, 12248-12253, published first online on Aug. 6, 2004).

Ninomiya et al. disclose a method of conducting homologous recombination comprising preparing filamentous fungi cells (*Neurospora crassa*) wherein the KU70 and KU80 genes are disrupted, and foreign DNA is introduced by electroporation; the reference discloses cells obtained by this method (see abstract, see Fig. 1, see Table 2, see Fig. 5, see Table 4).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 9, 10, 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooykus et al. (US PGPUB 2004/0073967) in view of Ninomiya et al. ([ref teaching genes].

Hooykus et al. disclose a method of conducting homologous recombination in a eukaryotic cell, in which the cell is mutant in the proteins (and genes encoding the proteins) involved in non-homologous recombination, such as KU70, LIG4, and introducing foreign DNA into said cells to conduct homologous recombination. (see pages 2-3, para. 0009, see 0014-0015). The reference discloses deletions mutants and knockout mutations in said genes. The reference discloses transformation by Ti plasmid method (para. 0014). The reference discloses cells resulting from the method.

The difference between the reference and the instant claims is that filamentous fungi, and Neurospora, are not used.

However, et al. disclose the Ku70 and Ku80 genes in Neurospora crassa, and deletions of said genes in Neurospora crassa. It would have been obvious to have utilized said Neurospora crassa strains in the method disclosed by Hooykus et al., since Hooykus et al. disclose that the disclosed method may be used for any eukaryotic cell in which homologous recombination of a foreign gene is desired. One would have been motivated to make the substitution by the desire to use the well known and well studied Neurospora crassa strain as a host for recombinant DNA homologous recombination, which is well known in the art to be useful for constructing recombinant strains. Based upon the teachings of the cited references, the high skill of one of ordinary skill in the art, and absent evidence to the contrary, there would have been a reasonable expectation of success to result in the claimed invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 9, 10, 13-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The MPEP states that the purpose of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application, of the specific subject matter later claimed by him. The courts have stated:

To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gostelli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966." *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

Further, for a broad generic claim, the specification must provide adequate written description to identify the genus of the claim. In *Regents of the University of California v. Eli Lilly & Co.* the court stated:

A written description of an invention involving a chemical genus, like a description of a chemical species, “requires a precise definition, such as by structure, formula, [or] chemical name,” of the claimed subject matter sufficient to distinguish it from other materials. *Fiers*, 984 F.2d at 1171, 25 USPQ2d 1601; *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 284985 (CCPA 1973) (“In other cases, particularly but not necessarily, chemical cases, where there is unpredictability in performance of certain species or subcombinations other than those specifically enumerated, one skilled in the art may be found not to have been placed in possession of a genus . . .”) *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

The MPEP further states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure of the sequence, it is “not a sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence.” MPEP § 2163. The MPEP does state that for a generic claim the genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. MPEP § 2163. If the genus has a substantial variance, the disclosure must describe a sufficient variety of species to reflect the variation within that genus. See MPEP § 2163. Although the MPEP does not define what constitute a sufficient number of representative species, the courts have indicated what do not constitute a representative number of species to adequately describe a broad generic. In *Gostelli*, the courts determined that the disclosure of two chemical compounds within a subgenus did not describe that subgenus. *In re Gostelli*, 872, F.2d at 1012, 10 USPQ2d at 1618.

The MPEP lists factors that can be used to determine if sufficient evidence of possession has been furnished in the disclosure of the Application. These include: (1) Actual reduction to practice, (2) Disclosure of drawings or structural chemical formulas, (3) Sufficient relevant identifying characteristics (such as: i. Complete structure, ii.

Partial structure, iii. Physical and/or chemical properties, iv. Functional characteristics when coupled with a known or disclosed, and correlation between function and structure), (4) Method of making the claimed invention, (5) Level of skill and knowledge in the art, and (6) Predictability in the art.

“Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient.” MPEP § 2163. While all of the factors have been considered, a sufficient amount for a *prima facie* case are discussed below.

In the instant case, the claims are drawn to a genus of methods of homologous recombination, wherein any filamentous fungi cells are prepared that have a decrease or loss of the functions of any gene necessary for non-homologous recombination (claim 1, 2, 3, 4,), or the gene is KU70, KU80, LigIV, DNA-PKcs, or XRCC4 from any filamentous fungi (claim 5), or any of Neurospora, Aspergillus, Penicillium, Fusarium, Trichoderma, or Mucor, and any gene necessary for non-homologous recombination (claim 9), or any gene in any Neurospora (claim 10), or any gene in any Aspergillus (claim 13). Claim 14-18 are drawn to the cells that result from the claimed methods.

As stated *supra*, the MPEP states that written description for a genus can be achieved by a representative number of species within a broad generic. It is unquestionable that claim(s) 1-5, 9, 10, 13-8, are broad and generic, with respect to all possible compounds encompassed by the claims. The possible structural variations are numerous since the claims encompass any or a large number of types genes of

filamentous fungi having the recited function of “a gene necessary for non-homologous recombination”, or specified such genes from any filamentous fungi (claim 5 only).

Specifically, the claims lack written description because although one of ordinary skill in the art could reasonably predict the nucleic acid sequence (structure) of a given gene that meets the functional limitation, other than the Ku70 and Ku80 genes of *Neurospora crassa* actually disclosed in the specification. The only guidance in the specification is directed to the isolation of these genes.

Although the claims recite some functional characteristics, the claims lack written description because there is no disclosure of a *correlation* between function and structure of the compounds beyond those compounds specifically disclosed in the examples in the specification. Moreover, the specification lack sufficient variety of species to reflect this variance in the genus. While having written description of the Ku70 and Ku80 proteins and genes encoding them, in *Neurospora crassa*, the specification does not provide sufficient descriptive support for the myriad of compounds embraced by the claims.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does “little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.”) Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of the claims and does not reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the entire scope of the claimed invention.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY VOGEL whose telephone number is (571)272-0780. The examiner can normally be reached on 7:00 - 3:30, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 1636

NV  
2/25/09